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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/931,492
Filing Date: August 16, 2001
Appellant(s): COLSON et al.

MAILED

NOV 05 2007

GROUP 3600

C. Paul Maliszewski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 3, 2007.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct

(4) Status of Amendments After Final.

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct

(5) Summary of the Invention.

The summary of the invention contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon.

6,339,767	Rivette et al.	1/2003
6,154,725	Donner	11/2000
6,401,206	Khan	6/2002

(9) Grounds of Rejection.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (US Patent 6,339,767) in view of Donner (US Patent 6,154,725) in view of Hoke Jr. (US Patent 6,947,909) and further in view of Khan et al (US Patent 6,401,206).

As per claim 11

Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with a document database; (Figures 2 and 3)

Rivette et al. ('767) does not explicitly disclose "electronically receiving said product document transmitted by a client's computer, and publishing said client document by adding said client document to said document database", Donner ('725) discloses "electronically receiving said product document transmitted by a client's computer,(Figure 1) and publishing said client document by adding said client document to said document database".(Figure 2) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to decrease the latency in document processing by utilizing electronic transmission means.

Examiner notes that the claimed feature of "wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product" is directed towards intended usage of the method and does not constitute a patentable feature.

Rivette et al. ('767) does not explicitly disclose "Digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint",

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Khan et al. ('206) method in order in order to decrease fraud by adding elements to verify authenticity such as time stamps.

Rivette et al. ('767) does not explicitly disclose "database is publically accessible", Donner ('725) discloses "database is publically accessible".(Figure 2; column 5, lines 44-57) It would have been obvious to one having ordinary skill in the art at the time the invention was

made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to form an IP portfolio utilize materila in the public domain..

Claim 33 is in parallel with claim 11 and rejected for the same reasons.

As per claim 2,
Rivette et al. ('767) discloses the method of claim 11,
wherein said product document and one or more attachment files said product document comprises a primary document and one or more attached files.(Figure 2)

Claim 24 is in parallel with claim 2 and rejected for the same reasons.

As per claim 3,
Rivette et al. ('767) discloses the method of claim 11,
wherein said attachment files include a sample deposition statement.(Column 18, lines 28-30)

Claim 25 is in parallel with claim 3 and rejected for the same reasons.

As per claim 4,
Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include an image of a sales brochure.(Figure 2)

Claim 26 is in parallel with claim 4 and rejected for the same reasons.

As per claim 5,

Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include an image of a purchase order.(Figure 2)

Claim 27 is in parallel with claim 5 and rejected for the same reasons.

As per claim 6,

Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include an image of a sales invoice.(Figure 2)

Claim 28 is in parallel with claim 6 and rejected for the same reasons.

As per claim 7,

Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include an image of a commercial Web site page.(Figure 2)

Claim 29 is in parallel with claim 7 and rejected for the same reasons.

As per claim 8,

Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include an image of a printed advertisement.(Figure 2)
Claim 30 is in parallel with claim 8 and rejected for the same reasons.

As per claim 9,
Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include a video clip.(Column 26, lines 9-16; Figure 2)
Claim 31 is in parallel with claim 9 and rejected for the same reasons.

As per claim 10,
Rivette et al. ('767) discloses the method of claim 2,
wherein said attachment files include an audio clip.(Column 26, lines 9-16; Figure 2)

Claim 32 is in parallel with claim 10 and rejected for the same reasons.

As per claim 13,
Rivette et al. ('767) discloses the method of claim 11,
Official Notice is taken that "obtaining a notarization record is performed by a
notarization vender web site in communication with said database" is common and well known
in prior art in reference to data management. It would have been obvious to one having ordinary
skill in the art at the time the invention was made to utilize a web site in order to allow document
retrieval from any site with Internet access.

Claim 35 is in parallel with claim 13 and rejected for the same reasons.

As per claim 14,

Rivette et al. ('767) discloses the method of claim 11,

Official Notice is taken that "charging said client a fee for adding said product document to said database" is common and well known in prior art in reference to data management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to charge a fee for adding a document to the database in order to raise revenue to maintain the upkeep of the database

Claim 36 is in parallel with claim 14 and rejected for the same reasons.

As per claim 15,

Rivette et al. ('767) discloses the method of claim 14,

Official Notice is taken that "fee is paid before said product document is added to said database" is common and well known in prior art in reference to data management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to charge a fee prior to adding a document to the database in order to raise revenue to maintain the upkeep of the database

Claim 37 is in parallel with claim 15 and rejected for the same reasons.

As per claim 16,

Rivette et al. ('767) discloses the method of claim 11,

further comprising the step of recording the number of times said product document is accessed by end users.(Column 36, lines 21-25)

Claim 38 is in parallel with claim 16 and rejected for the same reasons.

As per claim 19,

Rivette et al. ('767) discloses the method of claim 11,

further comprising the step of collecting and adding bibliographic data to said product document.(Column 18, lines 49-66)

Claim 41 is in parallel with claim 19 and rejected for the same reasons.

As per claim 20,

Rivette et al. ('767) discloses the method of claim 11,

wherein said product document is transmitted by said client's computer via one of a plurality of transfer protocols determined by said client.(Column 15, lines 2-3; Figure 3)

Claim 42 is in parallel with claim 20 and rejected for the same reasons.

As per claim 21,

Rivette et al. ('767) discloses the method of claim 20,

wherein said plurality of transfer protocols includes the HTTP and FTP.(Column 15, lines 2-3; Figure 3)

Claim 43 is in parallel with claim 21 and rejected for the same reasons.

As per claim 22,
Rivette et al. ('767) discloses the method of claim 11,
wherein said product document is published on a restricted basis for access only by users
and user groups selected by said client.(Column 36, lines 27-38)

Claim 44 is in parallel with claim 22 and rejected for the same reasons.

Allowable Subject Matter

Claims 17, 18, 39 and 40 are objected to as being dependent upon a rejected base claim, but
would be allowable if rewritten in independent form including all of the limitations of the base
claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the
payment of the issue fee and, to avoid processing delays, should preferably accompany the issue
fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for
Allowance."

(10) *Response to Argument.*

Examiner notes that the reference HOKE, Jr (US Patent 6,947,909) although cited in
header for the rejection has been withdrawn.

a.)

The Appellant states that Rivette does not teach a searchable database in communication
with a publication Web site;

The Examiner responds that this feature is clearly show by figure 3 of the Rivette reference; webserver (element 310) publishes data from Databases (element 316) via Enterprise server (element 314). The Examiner further states that all databases are inherently searchable, Rivette sates that his invention is capable of “patent mapping, inventor patent count etc... the Examiner submits that these functions would be impossible without some type of searching capability.

b.)

The Appellant states that Rivette teaches against a searchable database

The Examiner responds that all databases are inherently searchable, the Appellants arguments appear to be directed towards whether the database is publically accessible, which is a feature disclosed by the Donner reference. Rivette sates that his invention is capable of “patent mapping, inventor patent count etc... the Examiner submits that these functions would be impossible without some type of searching capability.

c.)

The Appellant states that Donner does not teach receiving a product document

The Examiner submits that as per column 5, lines 1-44 of the Donner reference, the client transmits information regarding an intellectual property portfolio to a database access device. Examiner submits that “intellectual property portfolio” could be construed as “a product document”, and it is clearly received by the database access device.

d.)

The Appellant states that Donner does not publish a product document

Examiner submits that this feature is clearly show by figure 3 of the Rivette reference; webserver (element 310) publishes data from Databases (element 316) via Enterprise server (element 314)

e.)

The Appellant states that there is no motivation to combine Rivette and Donner

The Examiner responds that the Appellants arguments are foreclosed in view of *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395, Where, as here “[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result,” In the instance of the present invention the Examiner submits that the combination of the prior are references yields a predictable result.

f.)

The Appellant states that the Examiner has applied impermissible hindsight , there is no teaching, suggestion, or motivation in the cited references to modify Rivette to form the claimed invention, nor is there any convincing reason as to why an artisan would be motivated to combine the references.

The Examiner responds that the Appellants arguments are foreclosed in view of *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395, Where, as here “[an application] claims a structure already

known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result,” In the instance of the present invention the Examiner submits that the combination of the prior art would have been obvious to a person having ordinary skill in the art at the time of the invention.

g.)

The Appellant states that Khan does not digitally notarize a product document with a timestamp and a digital fingerprint

The Examiner responds that this feature is explicitly disclosed by Khan as stated in the prior rejection. Specifically at column 4, lines 45-63 Khan states “A series of techniques can be used for the person's identity verification. First the cryptographic digital signature is verified which establishes the integrity of the document, and ensures non-repudiation of origin to the extent that it was signed by the holder of the private key. A time stamp or random number is used to establish that the document is not a duplicate presented as an original. In case of a dispute, digital identity marks, which are functions of the document and the personal identifiers, are used to verify that the digital signature indeed made the signature impression on the accompanying document.”

h.)

The Appellant states that Khan teaches against the invention recited in Claim 11; The product document of Claim 11 is placed in a publicly accessible database and is meant to be disseminated to and viewed by the public. Confidential and proprietary information by definition

cannot and is not made public. In virtually all cases, personal information is meant to remain non-public and typically, legal information also is kept confidential.

The Examiner responds that although in part Khan is directed towards protection of confidential and proprietary information, another aspect of the invention is “document and digital identity verification. (abstract). The Examiner contends that the feature of authenticating a document using a digital signature is equivalent to the feature of claim 11. A person having ordinary skill in the art at the time of the invention would have considered the feature disclosed by Khan to be adaptable to any type of information system, public or private.

i.)

The Appellant states that there is no motivation to combine Rivette and Donner

The Examiner responds that the Appellants arguments are foreclosed in view of *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395, Where, as here “[an application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result,” In the instance of the present invention the Examiner submits that the combination of the prior art references yields a predictable result.

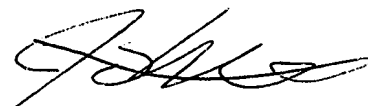
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained,

Respectfully submitted

John M Winter



Examiner
Art Unit 3621

JMW
October 28, 2007

Conferees;

Andrew Fischer

Vincent Millin



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